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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/349,105 07/08/99 RONDEAU

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EXAMINER
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IM22/0406

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EINSMANN, M	
ART UNIT	PAPER NUMBER

1751

DATE MAILED:

04/06/01

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/349,105

Applicant(s)  
Rondeau

Examiner  
Margaret Einsmann

Group Art Unit  
1751



☒ Responsive to communication(s) filed on Feb 13, 2001

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-55 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-55 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Response to Amendment***

Applicant's amendment of 2/13/2001 has been entered and applicant's remarks have been considered. The provisional obviousness double patenting rejections over claims of applications 09/350,579, 09/287,176, 09/349,436 are maintained as applicant has not presented terminal disclaimers. While applicant has traversed the rejections, no rebuttal is needed as no reasons for the traversal were presented. Applicant spends most of pages 24-29 of the response arguing a rejection that does not exist in this file. Thus no response is necessary to this argument.

The rejection of the claims under the second paragraph of 35 USC 112 is withdrawn due to applicant's amendments and arguments. This office notes that the basis for the amendment to claim 30 is not in the specification at page 34 lines 5-9, nor is the basis for the amendment to claim 45 at page 37 lines 3-4 as stated on page 30 of the response of 2/13/2001.

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Applicant states the basis for "lightening direct dyeing" in claim 42 is found on page 1 lines 8-17. There is no such terminology at that place. The basis is either "direct dyeing" or "lightening dyeing"
2. The rejection of claims 1-17, 25-29, 23-24, 38-47 under 35 U.S.C. 102(e) as being anticipated by Rondeau et al. is maintained for the reasons set forth in the office action of 9/13/2001.

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3. Applicant's arguments filed 2/13/2001 regarding the above rejection have been fully considered but they are not persuasive. Applicant states that the sawdust in example 2 is not a thickening polymer. Sawdust is wood, which is comprised mainly of cellulose. Cellulose is a polymer composed of sugar units. Applicant admits on the record that that is so, "...sawdust is ...a mixture composed of 67-80% holocellulose" Applicant states that the term "thickening polymer" is not intended to encompass sawdust. Yet applicant has not defined the term, either by a Markush group or otherwise, to exclude the cellulose of which sawdust is comprised. Is applicant stating that sawdust cannot be used as a thickener? Try adding large amounts of sawdust to water and see what results. Applicant next appears to dismiss sawdust because it is a "pulverulent excipient." How does this distinguish it from a thickening polymer?

4. The rejection of claims 1-55 under 35 U.S.C. 103(a) as being unpatentable over Rondeau et al. is maintained for the reasons set forth in the office action of 9/13/2000.

Applicant argues that there is too much picking and choosing to do in order to substitute a gum, starch or other sugar containing polymer from those in column 23 lines 24-31. There are only three choices given in the paragraph listing the organic excipients in the composition: (1) synthetic polymers, (2) polysaccharides [Note: all of these contain sugar units- the term means a plurality of sugar units] and (3) natural products [Note: all of those listed comprise sugar units]. Thus, not only does applicant teach the equivalence of the above three organic polymeric groups for addition to the composition, but most of those listed contain sugar units, thus reading on applicant's thickening polymer. Applicant states that there is no motivation to substitute another

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sugar containing polymer for the sawdust of example 2. All disclosures of the prior art, including non-preferred embodiment, must be considered. See *In re Lamberti and Konort*, 192 USPQ 278 (CCPA 1967); *In re Snow* 176 USPQ 328 (CCPA 9173) All of the disclosures in a reference must be evaluated for what they fairly teach to one of ordinary skill in the art. *In re Smith*, 32 CCPA 959, 148 F.2d 351, 65 USPQ 167; *In re Nehrenberg*, CCPA 1159, 280 F. 2d 161, 126 USPQ 383. Note M.P.E P. 2123, "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain. *In re Heck*, 699 E.2d 1331, 1332-1333, 216 USPQ 1038, 1039 (Fed Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.) cert. denied, 493 U. S. 975 (1989). Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). Applicant further states that there is no motivation to substitute any other polymer from the list in col 23 for the sawdust in example 2. There is no motivation needed to substitute equivalents as long as the prior art recognizes the equivalence. Such equivalence is taught at column 23 lines 24-31.

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5. Claims 1-9, 12-17, 22-31, 42 and 44-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kao Corporation.

Kao Corporation, EP 756,861 teaches compositions for dyeing Hair containing at least one direct dye, and a C2-4 hydroxyalkyl guar gum in the claimed amounts, wherein preferred Guars include the claimed nonionic hydroxypropyl Guar gum. See page 2 lines 17-20 and 25-27. Kao teaches that all direct dyes and mixtures thereof may be used in the claimed amounts but preferred dyes are the cationic dyes. See page 2 lines 39-56 where a long list of basic dyes is specifically mentioned. Note the examples, particularly example 2 which used hydroxypropyl guar in combination with a basic red dye. Kao does not give the structural formulae for the dyes. However, it would have been obvious to the skilled artisan from the statements on page 2, "All direct dyestuffs admitted for this purpose may be used as direct hair dyes" and "Preferred dyestuffs are cationic (basic) dyes since their stability and absorptive properties are particularly enhanced by the addition of Gar gum derivatives according to the invention" that the guar gum derivatives may be used in combination with any and all basic direct dyes in a hair dyeing process. Thus Kao's <sup>guar</sup>Gar gum would be expected to serve its known purpose of thickening a basic dye composition. It is not inventive to use a compound or composition for its known purpose.

6. Applicant's arguments filed 2/13/2001 have been fully considered but they are not persuasive. Applicant states that the claims have been amended to exclude the dyes in the Kao reference. Since there is not statement in the reference or any other place in this file as to the structure of any of the specific dyes in Kao, the amendment does not begin to overcome the

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rejection. Additionally, Kao's statements on page two indicate that the Guar gum has a known utility as a thickener in basic hair dye compositions and thus its use with any or all of the dyes in this application would have been obvious to the skilled artisan.

7. Claims 1-19, 25-31, 42-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lang, US 3,985,499. Applicant's arguments filed 2/13/2001 have been fully considered but they are not persuasive. This rejection is maintained as set forth in the previous action for the reasons set forth therein. Applicant has argued that the claims are no longer obvious over this reference because the proviso added to the claims has eliminated the dyes disclosed in Lang. Note applicant's dye III, where m is zero and E is E1. This dye is a position isomer of the dye in Lang. Note that structurally similar compounds are generally expected to have similar properties. In re Gyurik, 596 F. 2d 1012, 201 USPQ 552. Closely related homologs, analogs and isomers in chemistry may create a prima facie case of obviousness. *In re Dillon* USPQ 2d 1897, 1904 (Fed. Cir. 1990); *In re Payne* 203 USPQ 245 (CCPA 1979); *In re Mills* 126 USPQ 513 (CCPA 1960); *In re Henze* 85 USPQ 261 (CCPA 1950); *In re Hass* 60 USPQ 544 (CCPA 1944). It would have been obvious to the skilled artisan that the substitution of a dye which is a position isomer in the compositions of Lang would form a composition which would be expected to have similar properties.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is (703) 308-3826. The examiner can normally be reached on Monday to Thursday and alternate Fridays from 7:00 A.M. to 4:30 P.M. The fax phone number for this Technology Center is (703) 305-3599

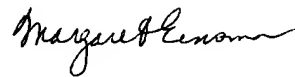


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.



MARGARET EINSMANN

PRIMARY EXAMINER 1751

April 5, 2001